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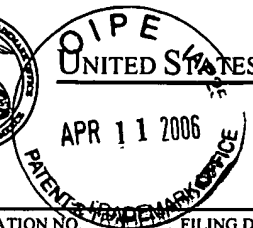


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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/168,644 | 10/08/1998 | MARK D. CONOVER | 2134 | 2742 |

7590 04/04/2006

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| EXAMINER | |
|---|---|
| LEE, RICHARD J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2621 | |

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/168,644 | CONOVER, MARK D. | |
| | Examiner | Art Unit | |
| | Richard Lee | 2621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Gordon of record (6,324,217).

Gordon discloses a method and apparatus for producing an information stream having still images as shown in Figures 1 and 3, and the same method for producing a compressed video bitstream that includes compressed video data for a plurality of frames that specifies a single still image as claimed in claim 1, comprising the same fetching that data for the still image (see input to 110 of Figure 1); encoding (i.e., 110 of Figure 1) the data for the single still image data into data for an I frame; storing (i.e., 111 or 121 of Figure 1) the encoded I frame data; assembling the compressed video bitstream by appropriately combining data for at least a single copy of the stored I frame (i.e., from 120 of Figure 1, see column 3, lines 36-47, column 3, line 61 to column 5), at least one null frame (i.e., from 120 of Figure 1, see column 3, lines 36-47, column 3, line 61 to column 5), and various headers required for decodability of the compressed video bitstream (see column 4, lines 5-43); and whereby decoding of the compressed video bitstream produces frames of video which produce images that do not appear to pulse visually (see column 3, lines 48-54, column 7, lines 26-58).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 3, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon as applied to claim 1 in the above paragraph (2), and further in view of Davis et al of record (5,838,678).

Gordon discloses substantially the same method for producing a compressed video bitstream as above, further wherein the assembled compressed video bitstream is decodable in accordance with the MPEG-1 and MPEG-2 standards (see column 3).

Gordon does not particularly disclose though the followings:

(a) wherein null frames assembled into the compressed video bitstream also include bitstream stuffing whereby the compressed video bitstream is transmittable at a pre-established bitrate as claimed in claim 5;

(b) the various headers assembled into the compressed video bitstream include a sequence header beginning the compressed video bitstream, at a beginning of group of pictures, a group start code, for each encoded frame, a picture start code, and a sequence end code ending the compressed video bitstream as claimed in claims 2 and 6; and

(c) the various headers assembled into the compressed video bitstream include a sequence header beginning the compressed video bitstream; for each encoded frame a picture header, and a picture coding extension; and a sequence end code ending the compressed video bitstream as claimed in claims 3 and 7.

Regarding (a) to (c), Davis et al discloses a method and device for preprocessing streams of encoded data to facilitate decoding streams back to back as shown in Figures 2, 3A, 3B, 5, and 6, and teaches the conventional assembling of the compressed video bitstream by appropriately combining data for headers such as sequence header, group start code, picture start code, sequence end code, picture header, and picture coding extension (see column 3, line 41 to column 4, line 16), as well as bitstream stuffings whereby the compressed video bitstream may be transmitted at a pre-established bitrate (see "stuffing bytes" in Figure 2). Therefore, it would have been obvious to one of ordinary skill in the art, having the Gordon and Davis et al references in front of him/her, would have had no difficulty in providing the required header data for the MPEG encoding/decoding as well as including the bitstream stuffings in the compressed video bitstream as shown in Davis et al for the compressed video data within encoder and decoder of Gordon for the same well known video bit processing and standard compliance purposes as claimed.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon as applied to claim 1 in the above paragraph (2), and further in view of Florencio of record (6,310,919).

Gordon discloses substantially the same method for producing a compressed video bitstream as above, but does not particularly disclose wherein parameters used in encoding the data for the still image produce an amount of data for the I frame that approaches, but remains less than, storage capacity of a buffer memory included in a decoder that stores the compressed video bitstream as claimed in claim 4. The particular storage of compressed video bitstreams within a decoder is however old and well recognized in the art, as exemplified by Florencio (see 111 of Figure 1 and column 5, lines 1-12). Therefore, it would have been obvious to one of

ordinary skill in the art, having the Gordon and Florencio references in front of him/her and the general knowledge of storage buffers within video image decoders, would have had no difficulty in providing the buffer memory within the decoder of Florencio for storage of and decoding of the compressed video bitstream of Gordon for the same well known buffering of data purposes as claimed.

6. It is to be noted that the applicant has not provided any sufficient showing of evidence under Rule 41.202 in order to provisionally remove the section 102(e) rejection for purposes of interference.

The applicant's introductory remarks at pages 2-5 of the amendment filed February 2, 2006 have been noted.

The applicant argued at pages 7-14 of the amendment filed February 2, 2006 concerning the description of the two embodiments of the Gordon patent, and specifically that a rejection based on 35 U.S.C. 102(e) can be overcome by (A) persuasively arguing that the claims are patentably distinguishable from the prior art; and (D) filing an affidavit or declaration under 37 C.F.R. 1.131 showing prior invention as defined in 37 C.F.R. 41.203(a) and MPEP 706.02(b), and 37 CFR 1.131 affidavits or declarations may be used to antedate a reference that qualifies as prior art under 35 USC 102(e), where the reference has a prior art data under 35 USC 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention. The applicant's attention is directed to MPEP 706.02(b), section (D), which states that "When the claims of the reference U.S. patent or U.S. patent application publication are directed to the same invention or are obvious invariants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection". Contrary to applicant's

contention, the present 35 U.S.C. 102 (e) therefore can not be overcome by an affidavit or declaration under 37 CFR 1.131 for reasons as set forth in MPEP 706.02(b) and since the Gordon patent is directed to the same patentable/claimed invention.

The applicant argued at pages 14-23 of the amendment filed February 2, 2006 concerning in general the traversal of the rejection under 35 USC 102(e) based upon the Gordon patent because the Gordon patent claims differ patentably from the subject matter encompassed by pending claim 1 and the Gordon patent lacks an enabling disclosure of pre-defined data structure NULL P-frames, and specifically that "the Gordon patent's independent claims, i.e. claims 1, 10 and 13, are all limited to the second, less preferred embodiment of the invention described in col. 4, line 66 – col. 5, line 6 ... The present application discloses only pre-defined data structure NULL P-frames as contrasted with the Gordon patent's claimed second , less preferred embodiment of the invention ... Applicant respectfully submits that controlling legal authority bars rejecting pending independent claim 1 under 35 USC 102(e) based upon the Gordon patent because the reference lacks an enabling disclosure of pre-defined data structure NULL P-frames ...". The Examiner respectfully disagrees. Contrary to the applicant's contention that the predefined data structure NULL P-frames as disclosed in the present application is contrasted with Gordon patent's claimed second embodiment which describes using a plurality of forward predictive coded frames (P-frames), the Examiner sees no difference between the NULL frames of the present application and the NULL frames of the Gordon patent (see column 4, lines 53-65). Also, contrary to the applicant's contention, the Gordon patent clearly claims the same patentable invention. And regarding the lack of an enabling disclosure by Gordon as argued by the applicant, the Examiner wants to point out that MPEP 2121 states that "When the reference is

relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable", and "The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other". Therefore, it is submitted that the Gordon patent contains an enabled disclosure and anticipates the claimed invention.

The applicant argued at page 23 of the amendment filed February 2, 2006 concerning in general that " ... the prior abandonment of the rejection of independent claim 1 under 35 USC 102(e) based upon the Gordon patent for more than three and one-half years in both the October 11, 2002, in the March 18, 2003, Office Actions and during Applicant's successful appeal of claim rejections appearing in those two Office estops rejecting independent claim 1 on that basis now ...". The Examiner however has reviewed the MPEP and was not been able to find such estoppel as purported by the applicant. Unless proven otherwise, it is submitted that the re-application of the Gordon reference is deemed proper (see also the comments by Judge Barrett in the Decision on Appeal dated June 7, 2005).

The applicant argued at pages 23-24 of the amendment filed February 2, 2006 concerning that "...Conover declaration traverses rejecting that claim under 35 USC 102(e) based upon the Gordon patent because the present application and the Gordon patent claim patentably different inventions ... the Gordon patent lacks an enabling disclosure of pre-defined data structure NULL P-frames ...". The Examiner wants to point out that such arguments have been addressed in the above.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Lee whose telephone number is (571) 272-7333. The Examiner can normally be reached on Monday to Friday from 8:00 a.m. to 5:30 p.m, with alternate Fridays off.

RICHARD LEE
PRIMARY EXAMINER

Richard Lee/rl

3/29/06

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